

REMARKS

The Office Action has been carefully considered. Claims 1-55 are pending. Claims 1, 7, 25, 31, 49, and 50 are presently amended. Claims 1-55 were rejected in the following manner.

1. Claims 1-9, 11-19, 21-33, 35-43, and 44-52 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent App. No. 2002/0083435 A1 to Blasko et al. ("*Blasko*") in view of U.S. Patent No. 6,718,551 to Swix ("*Swix*").
2. Claims 10, 20, 34, and 44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Blasko*, in view of *Swix*, and further in view of U.S. Patent No. 6,950,623 to Brown ("*Brown*").

35 U.S.C. §103 Rejections

In the Office Action, claims 1-9, 11-19, 21-33, 35-43, and 44-52 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Blasko* in view of *Swix*. Applicant respectfully disagrees with the rejections, but has nonetheless amended Claims 1, 7, 25, 31, 49, and 50 to further clarify patentable distinctions over *Blasko* in view of *Swix*.

As presently amended, Claim 1 reads as follows:

In a client system, a method of operation comprising
providing an advertisement publisher with a profile of the user of
client system at a predetermined time prior to streaming of a program;
asynchronously caching, at a client cache, a plurality of
advertisements of various time lengths **contemporaneous with streaming of
a program**; and
causing one or more of said cached advertisements to be
synchronously rendered during an advertisement time slot of a streaming
program, replacing advertisements, if any, included in the streaming program
for the advertisement time slot.

Two amendments have been made to clarify the operation of the method and the intended scope of protection. Specifically, Claim 1 now recites "**asynchronously** caching... a plurality of advertisements... **contemporaneous with streaming of a program.**" The amended language clarifies the timing of and manner in which the advertising caching takes place on the client system. Claim 25 recites similar elements and is presently amended similarly.

Blasko in view of *Swix* does not teach or suggest "asynchronously caching... a plurality of advertisements... contemporaneous with streaming of a program," as claimed in Claim 1.

Thus, Claim 1 now specifies that caching is “contemporaneous” with the streaming of a program. In other words, “pre-caching of the advertisements from advertisement publisher/server 110 are adaptively performed, **even while the receipt of the streaming content or program are in progress**, to maintain availability of the substitute or replacement advertisements.” Page 6 line 25-Page 7 line 1.

In addition, Claim 1 now specifies that the advertisements are cached “asynchronously,” meaning that the ads are not cached at the same rate or exactly together with any other programs or ads that the client may be receiving. For example, “[t]o serve [a 30-second ad sampled at 8 kbps] at 3 kbps, the server would take 80... seconds.” Page 14 lines 10-13. Thus, ads are not cached at the same rate as a program that is streaming in real time contemporaneously with the ad download.

Applicant respectfully submits that neither *Blasko* nor *Swix*, alone or in combination, teaches or even suggests “**asynchronously** caching... a plurality of advertisements... **contemporaneous with streaming of a program.**” On the contrary, *Blasko* discloses merely that advertisements may be provided through one or more broadcast channels and that “the subscriber system may retrieve [such advertisements] **in real time** for insertion or store **ahead of time.**” Para. [28]. Interpreted broadly, *Blasko* may suggest merely that advertisements may be retrieved either synchronously (e.g., in real time, from an ad channel) or non-contemporaneously (e.g., ahead of time).

Similarly, *Swix* teaches merely that the client device “off-tunes” to an alternate, **synchronously** broadcast ad-only channel for a period of time. For example,

the set-top boxes off-tune to the separate advertisement channel for the specified duration and tune back to program broadcast 500 after the advertisement insertion slot to resume watching the continuous broadcast program.

The separate advertisement channel can be either another programming channel whose advertisement insertion slots coincide with program broadcast 500 or can be a continuous stream of advertisements with no programming.

Col. 13 lines 29-40. Thus, *Swix* teaches that contemporaneous with the streaming of a program, ads are not cached at all, let alone asynchronously cached. Rather, *Swix* teaches that ads to be displayed contemporaneous with the streaming of a program are obtained synchronously, in real time, from a separate advertisement channel.

In other circumstances, *Swix* does teach that ads may be pre-cached, but only for use in an “interactive session,” not asynchronously, and not contemporaneous with a streaming program. *Swix*’s Fig. 3 illustrates a typical “interactive session,” wherein a user drills down through a series of menu screens to choose, for example, a pay per view movie. Col. 10 lines 35-51. Thus, it is clear that an “interactive session” is not contemporaneous with the streaming of a program (the pay per view movie).

Moreover, *Swix* teaches that if an ad is not found to be cached locally, “the navigator simply reverts to querying file server 102 and **waiting** for the downloading of the bit map or video advertisement” (emphasis added). Col. 11 lines 49-51. Thus, *Swix* teaches that ads are **not** asynchronously cached simultaneous with a streaming program, but that if ads must be downloaded, the client must simply **wait** for their complete arrival. In fact, *Swix* teaches one of the problems that Claim 1 is able to overcome through asynchronous, contemporaneous caching, namely, “maintain[ing] availability of the substitute or replacement advertisements,” “even while the receipt of the streaming content or program are in progress.” See Page 6 line 25-Page 7 line 1.

Thus, neither *Blasko* nor *Swix* individually or in combination teaches or even suggests “asynchronously caching... a plurality of advertisements... contemporaneous with streaming of a program,” as claimed in Claim 1.

Furthermore, both *Blasko* and *Swix* disclose solutions that are incompatible with the method of Claim 1. Accordingly, even if *Blasko* and *Swix* could somehow be interpreted so broadly as to separately teach the elements of Claim 1, one of ordinary skill would not have been motivated to combine them to obtain the claimed invention because both references teach away from the combination. See *KSR International Co. v. Teleflex Inc.*, 550 U.S. at ___, 82 USPQ2d at 1395 (“When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious.”)

For at least the reasons just discussed, Applicant respectfully submits that the Office Action has failed to state a *prima facie* case that Claim 1 is obvious. Therefore, Applicant respectfully submits that Claim 1 is patentable over *Blasko* in view of *Swix*.

Claims 25 and 49 are allowable by similar reasoning.

Claims 25 and 49 recite elements that are similar to those discussed with respect to Claim 1 and are allowable by similar reasoning.

Blasko in view of Swix does not teach or suggest a “rendering quality objective,” as claimed in Claim 7.

Claim 7 also includes similar elements and is also allowable at least by similar reasoning. But Claim 7 also adds a new element that is not taught or suggested by *Blasko* in view of *Swix*. The previous version of Claim 7 read, “adaptively retrieving a plurality of advertisements in a manner that is consistent with a **quality objective for receiving and rendering said streaming program** on said client system.” The “quality objective for... rendering said streaming program” is described in the specification as follows: “advertisement module 106 determines an appropriate download rate for downloading the advertisements, such that downloading of the advertisements **will not consequentially interfere, or at least not in a discernable manner, with the quality of the streaming program.**” Page 12 lines 23-26. Thus it is clear that “quality” refers to the user-perceived **fidelity** of the rendered program.

In the Office Action, Claim 7 appears to have been rejected with disregard for the restrictive phrase “for... **rendering** said streaming program,” which modifies “quality objective.” Consequently, “quality objective” was interpreted unreasonably broadly, having been given a meaning with virtually no relationship to the claim or the specification: “[t]he examiner interprets a quality objective to be a performance (quality) criteria (objective).” The Office Action goes on to analogize Claim 7’s “quality objective” to *Blasko*’s teaching that a performance criterion may not be met if an ad is not displayed because, for example, a user’s television is not turned on. In other words, *Blasko* teaches merely that there may be performance metrics completely unrelated to any rendering fidelity (quality), metrics such as the number of times an ad is displayed on a television that is turned on. Claim 7 is therefore amended to clarify that a “quality objective” does not refer to criteria such as whether an ad is displayed while a user’s television is turned on.

Rather, it is claimed that advertisements are retrieved in a “manner that is consistent with a **rendering quality objective for contemporaneously receiving and rendering said streaming program** on said client system.” To paraphrase, advertisements are retrieved with the goal (e.g., objective) of ensuring the fidelity (e.g., quality) of the rendered streaming program (whether audio, video, images, or any other medium). Thus, when the claim is properly interpreted, a quality objective relates to the rendering of a contemporaneous

streaming program. Applicant believes there is no other reasonable interpretation of the phrase “manner that is consistent with a rendering quality objective for contemporaneously receiving and rendering said streaming program.” Accordingly, *Blasko* in view of *Swix* cannot be said to teach or even suggest this element of Claim 7.

Blasko in view of *Swix* does not teach or suggest receiving advertisements “in an adaptive manner,” as claimed in Claim 7.

Moreover, in the Office Action, the rejection of Claim 7 glossed over the word “adaptive.” However, Claim 7 is also allowable because neither *Blasko* nor *Swix* teaches or even suggests “asynchronously retrieving a plurality of advertisements **in an adaptive manner** that is consistent with a rendering quality objective for contemporaneously receiving and rendering said streaming program on said client system,” as claimed in presently-amended Claim 7.

Here, “adaptive” is used as the adjective form of the **intransitive** verb “adapt,” which according to the New Oxford American Dictionary, means to become adjusted to new (changed) conditions. (The plain text of Claim 7 specifies the intransitive form of “adapt” because the word has only a subject—“manner”—and no object.)

Specifically, the “manner” is adapted based on changing conditions related to the rendering quality objective discussed above. This meaning is clear from the plain syntax and text of Claim 7 because “that is consistent with a rendering quality objective...” is a restrictive clause that limits the possible meaning of “an adaptive manner” (the preceding subject).

Thus, “retrieving... advertisements **in an adaptive manner** that is consistent with a rendering quality objective” can only properly be interpreted to mean that advertisements are retrieved in a manner that adjusts based on the changing rendering quality of a streaming program. *Blasko* in view of *Swix* does not teach or even remotely suggest this element of Claim 7. Accordingly, Claim 7 is allowable for this additional reason.

Claims 8, 31-32, and 50-51 are allowable by similar reasoning.

Claims 31 and 50 recites elements that are similar to those in Claim 7 and are allowable by similar reasoning. Claims 8, 32, and 51 are presently amended to harmonize

terminology with Claims 7, 31, and 50. Applicant respectfully submits that Claims 8, 32, and 51 are allowable by similar reasoning.

Claims 2-6, 9-24, 26-30, 33-48, and 52-55 are allowable at least be dependency.

Applicants respectfully submit that dependent Claims 2-6, 9-24, 26-30, 33-48, and 52-55 are allowable at least because each of these claims depends directly from a claim that has been shown to be allowable.

One of ordinary skill would have had no motivation to combine the cited references.

The preceding arguments are believed sufficient to address the issues raised in the Office Action. Therefore, Applicants need not spend a considerable time discussing the lack of motivation to combine the cited references. However, under the Supreme Court's most recent ruling on the matter, it remains important to avoid the use of hindsight reasoning when combining references. *See KSR International Co. v. Teleflex Inc.*, 550 U.S. —, 127 S.Ct. 1727, 1742; *see also Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 36, 86 S.Ct. 684 (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "guard against slipping into the use of hindsight"). Applicants respectfully submit that only the blueprint provided by Applicants' claims can provide any plausible motivation to combine so many disparate elements from *Blasko*, *Swix*, and *Brown* in the manner asserted in the Office Action. Accordingly, Applicants respectfully submit that for this additional reason, the Office Action has failed to state a prima facie case of obviousness for Claims 1-55.

CONCLUSION

For at least the reasons above, Applicants respectfully submit that Claims 1-55 are allowable and request that the Examiner permit these claims to proceed to issuance. Although additional arguments are believed to exist for distinguishing the cited documents, the arguments presented are believed sufficient to address the Examiner's rejections. Likewise, failure of the Applicant to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead, it is believed that the Examiner's positions are rendered moot by the foregoing arguments, and it is therefore not believed necessary to respond to every position taken by the Examiner with which Applicants do not agree.

The Examiner is respectfully requested to contact the undersigned at the telephone number below if there are any remaining questions regarding this application.

We believe the appropriate fees accompany this transmission. If, however, insufficient fee payment or fee overpayment occurs, the amount may be withdrawn or deposited from/to Axios Law Group's deposit account. The deposit account number is 50-4051.

Respectfully submitted,
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